

**REMARKS**

No claims are being added. Claim 53 is being cancelled without prejudice to filing in a later application. Claims 1, 54, 56, 57 and 59 are being amended. Upon entry of this amendment claims 1, 6, 9, 12, 21, 23, 38-43, 52 and 54-59 will be pending in the application. The amendment and new claims add no new matter.

The amendment to claim 1 is supported by, for example, the specification and claim 53.

The amendment to claims 54, 56 and 57 is supported by the specification at, for example, paragraph 0034 and Table 3. The amendment to claim 56 also follows the suggestion in the Action.

**1) Applicants' response to the objection of claim 53.**

Claim 53 was indicated in the Office Action Summary to be objected to. Claim 53 was NOT indicated in the Action to be rejected. There was no explanation in the Action of the basis for the objection to claim 53.

Applicants' can only interpret the Action to indicate that claim 53 contains patentable subject matter but is objected to because of dependency on a rejected parent claim. Applicants have moved the features of claim 53 into parent claim 1. Parent claim 1, and claims depending therefrom, should now be patentable.

**2) Applicants' response to the objection to claim 59.**

Claim 57 recites in one pertinent part: "A mold release composition prepared from a mixture consisting essentially of: . . ." The transitional term "consisting essentially of" in claim 57 allows inclusion of certain other unrecited components in the composition.

Claim 59 recites in one pertinent part: "A mold release composition according to claim 57, wherein the mixture consists of . . ." The transitional term "consists of" in claim 59 eliminates inclusion of other unrecited components in the composition.

Thus, use of the transitional term “consisting of” in claim 59 further limits the scope of claim 59 as compared to the term “consisting essentially of” in claim 57.

**3) Applicants' response to the rejection of claims 56 and 58-59 under 35 U.S.C §112, second paragraph.**

Claims 56 and 58-59 are rejected under 35 U.S.C. § 112, second paragraph for the reasons given in point 5 of the Action.

**• claim 56 – use of “optionally”**

Claim 56 recites in one pertinent part:

A mold release composition prepared from a mixture comprising: . . .

optionally, 0.05 to 38 percent by weight of mixture of at least one component selected from the group consisting of wetting agent, surfactant, slip agent, dye and transfer control agent; and . . .

Claim 56 thus recites that the at least one component may be optionally present in the composition. If the at least one component is present, it is within a range of 0.05 to 38 percent by weight. Claim 56 is definite.

**• claim 58 - use of “optionally”**

With reference to the similar claim 56 rejection above, the claim 58 recites that the at least one component may be optionally present in the composition. If the at least one component is present, it is within a range of 0.04 to 36.4 percent by weight. Claim 58 is definite.

**• claim 58 - use of “one component”**

Claim 58 recites in one pertinent part: “optionally 0.04-36.4 weight percent of the at least one component; . . .” The phrase “of the at least one component” in claim 58 refers back to the recitation of “optionally at least one component selected from the group consisting of catalyst, wetting agent, surfactant, slip agent, dye and transfer control agent” in parent claim 57. Claim 58 is definite.

**4) Applicants' response to the rejection of claims 54 and 56-59 under 35 U.S.C §112, first paragraph.**

Claims 54 and 56-59 are rejected under 35 U.S.C. § 112, first paragraph for the reasons given in point 7 of the Action.

**• claims 54 and 57**

Claim 54 is amended to recite: "The mold release composition according to claim 1 wherein the mold release composition has 0 to 1 percent by weight of composition of non-functional siloxane." Claim 57 recites similarly amended features.

Applicants' specification at paragraph 0034 teaches that slip agents such as non-functional siloxanes can be used in Applicants' composition. Table 3 (page 13) of Applicants' specification teaches that slip agents can comprise 0-20 weight percent of the composition. The claimed recitation of 0 to 1 percent falls within, and is supported by, the Table 3 disclosure.

**• claim 56**

Claim 56 has been amended. This rejection is obviated in view of the amendment.

**• claims 58 and 59**

Applicants did not see a rejection of claims 58 and 59 under 35 U.S.C. § 112, first paragraph.

**5) Applicants' response to the rejection of claims 1, 6, 9, 12, 38, 40-43, 52 and 55-56 under 35 U.S.C. §102(b).**

Claims 1, 6, 9, 12, 38, 40-43, 52 and 55-56 were rejected under 35 U.S.C. §102(b) as allegedly having every feature and interrelationship anticipated by International Publication No. WO 01/40417 to Giraud et al<sup>1</sup>, for the reasons given in point 8 of the action. Applicants traverse this rejection.

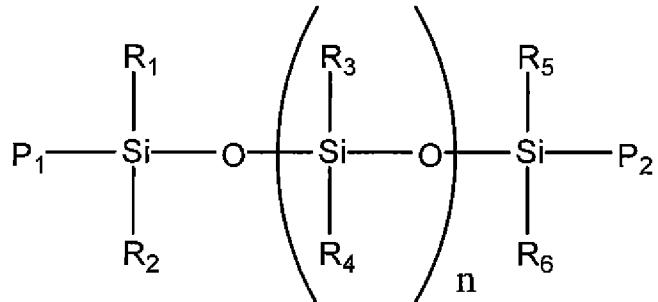
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<sup>1</sup> All references to Giraud in this Response refer to U.S. Patent No. 6,825,153 which is indicated by the Office to be equivalent to the WO 01/40417 document.

**a) The rejection is improper as Giraud does not teach or suggest all of the features of Applicants' claimed composition.**

Currently amended claim 1 recites:

A mold release composition having a pH of 7 to 11 comprising a functional siloxane, having the following structure:



where  $R_1$ ,  $R_2$ ,  $R_3$ ,  $R_4$ ,  $R_5$  and  $R_6$  individually can be the same or different, each being selected from the group consisting of  $C_{1-3}$  alkyl, vinyl, hydride, and alkoxy groups, where  $n$  is about 0 to about 100,000, and where  $P_1$  and  $P_2$  can be the same or different, each being selected from the group consisting of silanol, hydride, hydroxyl, alkyl, vinyl, carbinol and carboxy groups; a crosslinker, a thickening agent, an aliphatic ethanolamine base additional to the functional siloxane, the crosslinker and the thickening agent, and water.

**i) Giraud does not disclose an "aliphatic ethanolamine base".**

This limitation is not asserted to be present in Giraud. Further, this limitation is similar to the features of claims 53 and 57 which the Office admits are NOT rejected over Giraud. Claims 1, 6, 9, 12, 38, 40-43, 52 and 55-56 are patentable for at least this reason.

**ii) Giraud does not disclose a "pH".**

The only recitation of pH is column 16, TABLE 2 referring to pH of a Styrene-acrylic latex material. Giraud does not disclose a pH for the composition nor is there any reason that the Giraud composition must necessarily have a pH of 7 to 11. Claims 1, 6, 9, 12, 38, 40-43, 52 and 55-56 are patentable for at least this reason.

**b) The rejection is improper as it lacks identification of a lead compound and explanation of how and why the lead compound is modified to arrive at a claimed compound required for a prima facie case of obviousness.**

After KSR a prima facie case of obviousness for a chemical compound still, in general, begins with the reasoned identification of a lead compound and comparison of that lead compound to the claimed compound.<sup>2</sup>

**i) Giraud discloses a huge genus of siloxane compounds.**

Giraud at column 3, line 55 to column 5, line 19 discloses a vast number of possible siloxane resin molecules (Giraud constituent (b)) having many different possible structures. Giraud at column 5, line 20 to column 7, line 32 discloses a vast number of possible silane crosslinking agent molecules (Giraud constituent (c)) having many different possible structures.

**ii) The rejection does not identify a “lead compound” or show how to modify that lead compound to arrive at Applicants’ claimed structure.**

The rejection does not identify where either Applicants’ functional siloxane of claim 1 or crosslinker of claim 6 is found in Giraud. The rejection does not indicate which of Giraud’s components a to h allegedly anticipate which of Applicant’s recited components. The Office rejection does not identify a “lead compound”; does not identify any reason to choose that lead compound from the vast number of possibilities in Giraud; does not identify differences between that lead compound and Applicants’ claimed structures and does not identify any reason to modify the “lead compound” to arrive at Applicants’ claimed structure. The rejection merely reiterates that components a to h are present and that the “reference discloses all the limitations of the claims”. The rejection does not establish a prima facie case of obviousness. Claims 1, 6, 9, 12, 38, 40-43, 52 and 55-56 are patentable for at least this reason.

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<sup>2</sup> MPEP section 2144.08(II)(A)(1 and 2). See also Eisai Co. v. Dr. Reddy's Labs., Ltd, 533 F.3d 1353 (Fed. Cir. 2008) and Takeda Chemical Industries, Ltd. v. Alphapharm Pty, Ltd., 492 F.3d 1350 (Fed. Cir. 2007).

**c) Claim 56 is patentable for similar reasons.**

Claim 56 recites in one pertinent part: ". . . 0.1 to 2 percent by weight of mixture of an ethanolamine base additional to the functional siloxane, the crosslinker and the thickening agent; . . ." This limitation is not asserted to be present in Giraud. Further, this limitation is similar to the features of claims 53 and 57 which the Office admits are NOT rejected over Giraud. Claim 56 is patentable for at least this reason.

**6) Applicants' response to the rejection of claims 1, 6, 9, 12, 38, 40-43, 52 and 55-56 under 35 U.S.C. §103(a).**

Claims 1, 6, 9, 12, 38, 40-43, 52 and 55-56 were alternatively rejected under 35 U.S.C. §103(a) as allegedly being obvious over International Publication No. WO 01/40417 to Giraud et al, for the reasons given in point 8 of the action. Applicants traverse this rejection. As discussed above Giraud does not disclose features recited in parent claim 1. Claims 1, 6, 9, 12, 38, 40-43, 52 and 55-56 are patentable for at least these reasons.

**7) Applicants' response to the rejection of claim 21 under 35 U.S.C. §103(a).**

Claim 21 was rejected under 35 U.S.C. §103(a) as allegedly being obvious in view of International Publication No. WO 01/40417 to Giraud et al, for the reasons given in point 9 of the Action. Applicants traverse this rejection.

**a) The rejection is improper as Giraud does not teach or suggest all of the features of Applicants' claimed composition.**

As discussed above Giraud does not disclose features recited in parent claim 1. Claim 21 is patentable for at least these reasons.

**8) Applicants' response to the rejection of claim 23 under 35 U.S.C. §102(b) or alternatively under 35 U.S.C. §103(a).**

Claim 23 was rejected under 35 U.S.C. §103(a) as allegedly being obvious in view of International Publication No. WO 01/40417 to Giraud et al and further as

Application No. 10/522,842  
Atty. No.: LCS-103/PCT/US

evidenced by U.S. Patent No. 2,891,920 to Hyde and Silicones (Freeman, London-Iliffe Books, Ltd. (1962), for the reasons given in point 10 of the action. Applicants traverse this rejection.

**a) The rejection is improper as Giraud does not teach or suggest all of the features of parent claim 1.**

As discussed above Giraud does not disclose features recited in parent claim 1.

Claim 23 is patentable for at least these reasons.

**9) Applicants' response to the rejection of claim 39 under 35 U.S.C. §103(a).**

Claim 39 was rejected under 35 U.S.C. §103(a) as allegedly being obvious in view of International Publication No. WO 01/40417 to Giraud et al, for the reasons given in point 11 of the action. Applicants traverse this rejection.

Claim 39 recites:

A mold release composition according to claim 1, comprising the following composition:

0.04-2.99 weight percent silanol-functional siloxane;  
0.018-4.98 weight percent alkoxy-functional crosslinker;  
0.009-2 weight percent catalyst;  
0.04-4.8 weight percent thickening agent activatable at a pH of 7 to 11; and  
0.1-2 weight percent base.

**a) The rejection is improper as Giraud does not teach or suggest all of the features of parent claim 1.**

As discussed above Giraud does not disclose features recited in parent claim 1.

Claim 39 is patentable for at least these reasons.

**b) The assertion that all of the recited features of claim 39 are “result-effective variables” is incorrect and unsupported.**

The rejection asserts that the amounts of each of Applicants' recited siloxane, crosslinker, catalyst, thickening agent and base are nothing more than “result effective variables”.

As stated in In re Antonie, 559 F.2d 618; 195 U.S.P.Q. 6 (CCPA 1977):

The PTO . . . appear to argue that it would always be obvious for one of ordinary skill in the art to try varying every parameter of a system in order to optimize the effectiveness of the system even if there is no evidence in the record that the prior art recognized that particular parameter affected the result. As we have said many times, obvious to try is not the standard of 35 USC 103.

If a parameter is not recognized in the prior art as one that would affect results it is not obvious to vary that parameter. Ex parte Whalen II, 14, appeal 2007-4423 (BPAI 2008).

There is no teaching or disclosure in Giraud concerning a pH of 7-11, use of a base or use of a thickening agent activatable at a pH of 7 to 11. There is no evidence of record that a pH of 7-11, use of a base or use of a thickening agent activatable at a pH of 7 to 11 is recognized in the record as a result effective variable.

As stated in In re Lee, 61 USPQ2d, 1430 (Fed. Cir. 2002):

The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to patentability. [When] the examiner and the Board . . . rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

Claim 39 is patentable for at least this reason.

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Application No. 10/522,842  
Atty. No.: LCS-103/PCT/US

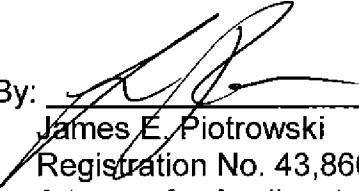
In summary, Applicants have addressed each of the objections and rejections in the present Office Action. It is believed the application now stands in condition for allowance, and prompt favorable action thereon is respectfully solicited.

The Examiner is invited to contact Applicants' attorney if a conversation will hasten prosecution of this application. All postal correspondence should be directed to the address given below.

Respectfully submitted,

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Date: 5-29-09

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